REMARKS

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-11, 28-47 and 53-60 are pending in the application, with 1, 36 and 60 (new) being the independent claims. Claims 12-27 and 48-52 are cancelled without prejudice to or disclaimer of the subject matter therein. In response to the election of species, claims 3-11, 37, 38, 41, 42, 44 and 45 are withdrawn from consideration pending the allowance of generic claims 1 and 36. Claims 53-59 are new and depend on generic claim 36, therefore they read on the elected species. New independent claim 60 also reads on the elected species. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Summary of Examiner Interview (Removal of Finality of Office Action)

Further to a telephone conversation with the Examiner on August 18, 2005, with Teresa Medler, Esq., and in accordance with MPEP §706.07(a), the finality of the Office Action has been withdrawn.

Rejections under 35 U.S.C. § 103

Claims 1, 2, 28-31, 36, 39, 40, 43, 46 and 47 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. Appl. Pub. 2003/0129464 to Becerra *et al.* in view of U.S. Patent 6,641,240 to Hsu *et al.* Office Action, p. 2. The Examiner relies on Becerra as disclosing the desirability of having a fuel gauge that allows the volume remaining in the fuel

container to be discerned, and concedes it "does not teach a gauge having a moving member and a static member." Office Action, p. 2. The Examiner states that Hsu teaches

> a container (reference item 100) having a bladder (reference item 115). Attached to the container and bladder is a capacitive sensor (reference item 210) having a movable plate member (reference item 210a) and a static plate member (reference item 210b).

Office Action, p. 3. The Examiner then states that "one of ordinary skill in the art at the time of the invention [would be motivated] to modify the teachings of Becerra *et al.* with the teachings of Hsu *et al.* in order to provide a gauge for determining the amount of fuel remaining in a fuel container." Office Action, p. 3.

Applicants respectfully traverse this rejection, as the combination of references does not teach or suggest every element of the claims. Each of independent claims 1 and 36 recites that a first location/sensor is movable within or associated with the fuel supply and a second location/sensor is ***on or associated with the fuel cell or the electronic equipment powered by the fuel cell***. Each of Becerra and Hsu only contemplate measuring the volume within the fuel supply, *i.e.*, Becerra's "fuel container 602" and Hsu's "ink tank 100", by devices ***within*** the fuel supply, *i.e.*, Becerra uses a visual gauge (604) and Hsu uses the sensor (210). Neither Becerra or Hsu, alone or in combination, teaches or suggests using a second location/sensor ***on or associated with*** an apparatus with which the fuel container/ink tank is utilized. Thus, claims 1 and 36 are patentable over the combination of Becerra and Hsu.

Furthermore to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. However, of note is that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art *and not based on applicant's disclosure*. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

As in the Examiner's previous rejection, Applicants respectfully assert that there is no motivation to combine the above-mentioned references to arrive at the Applicants' invention other than the Applicants' disclosure. The Examiner relies on Becerra for teaching the desirability of having a fuel gauge that allows the volume remaining in the fuel container to be discerned. Office Action, p. 2. However, as Applicants noted in the previous response, Becerra teaches a ***visual*** fuel gauge with a transparent window that provides "a visual indication of the amount of fuel" that it is "simple and accurate." Becerra, ¶47. The Examiner ignores that Becerra states a desirable feature of its fuel gauge is its simplicity and states that "one of ordinary skill in the art at the time of the invention [would be motivated] to modify the teachings of Becerra with the teachings of Hsu *et al.* in order to provide a gauge for determining the amount of fuel remaining in a fuel container." Office Action, p. 3. There is no support in the Becerra reference for this suggestion, as the reference does not teach or suggest the desirability of such a modification in its "simple and accurate" windowed fuel gauge. Further, Hsu does not provide such motivation to modify the fuel container of Becerra, as it is in a non-related field of endeavor.

The Examiner has taken the non-related teachings of these references and attempted to construct Applicants' invention therefrom. The motivation to combine the references and the expectation of success in making the modification of Becerra's device to arrive at Applicants' invention is found only in Applicants' disclosure, which is impermissible. Further as noted, this combination of references does not teach each and every element of Applicants' claimed invention.

In view of the foregoing, Applicants maintain that the Examiner has not made a *prima facie* case of obviousness with respect to claims 1, 2, 28-31, 36, 39, 40, 43, 46 and 47. Accordingly independent claims 1 and 36 are not obvious in view of and are patentable over the combination of the Becerra and Hsu references. New independent claim 60 is submitted to define the invention more clearly and is patentable over the Becerra and Hsu references for at least the same reasons as discussed above. Claims 2 and 28-31 depend from and add further features to independent claim 1 and claims 39, 40, 43, 46 and 47, as well as new claims 53-59, depend from and add further features to independent claim 36 and are patentable over this combination of references for this reason alone. While it is not necessary to address the Examiner's rejections of these claims at this time, Applicants reserve the right to support their patentability, when necessary.

Claims 32-35 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Becerra and Hsu as applied to claim 1 above, and further in view of U.S. Pat. Appl. Pub. No. 2003/0006245 to Rodgers and U.S. Patent No. 5,816,224 to Welsh *et al.* As discussed above, claim 1 is patentable over the Becerra and Hsu references. Claim 1 is also patentable over the Rodgers and Welsh references in combination with Becerra and Hsu, as the references do not make up for the deficiencies in the primary references. Claim 32-35

depend from and add further features to claim 1 and are patentable over this combination of references for this reason alone. While it is not necessary to address the Examiner's rejection of this claim at this time, Applicants reserve the right to support its patentability, when necessary.

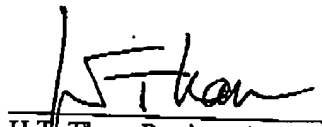
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

Date: September 28, 2005



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